

REMARKS

A. Supplemental Declaration

Applicants are filing a Supplemental Declaration that contains a claim of priority to a previously filed provisional application. The specification has been amended to include a claim of priority to the provisional application along with a claim of priority to a corresponding PCT application.

B. 35 U.S.C. § 112

1. 35 U.S.C. § 112, first paragraph.

Claims 3-7 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time of the application was filed, had possession of the claimed invention. Applicants traverse the rejections and respectfully request the Examiner to withdraw the pending rejections in light of the following remarks.

Claims 3-7 as rejected prior to the present Amendment are original claims that have not been amended since the filing of this Application. For the original claims, there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. The Examiner has a burden to rebut the presumption by providing a reasonable basis to challenge the adequacy of the written description. *See In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971); MPEP §§ 2163.01-2163.04. The Office Action asserts that the stanchion claimed as having surfaces that are attached one to another in

claim 3 is different from a description on page 11 and shown in Figures 5-11. In particular, the Office Action asserts that in the specification, the walls of the stanchion are described as “integrally attached”; that the meaning of the phrase, “integrally attached” is unclear and if parts are attached, they must be separable; that the inner wall 116 and the outer wall 118 are not identified in Figures 5-11; that if the front wall 112 has been attached to the integral walls, the attachment means is not described and it is not shown as a separate part; and that surfaces 124, 126 appear to be edges of a side wall and the term, “surface” is an incorrect term for the edges. Applicants respectfully submit that the Office Action fails to provide a reasonable basis to challenge the adequacy of the written description for several reasons.

First, the Office Action asserts that “surfaces” of the stanchions are attached one to another in claim 3, whereas “walls” of the stanchions are “integrally attached” in the specification. Claim 3 is amended to change “a rear surface” to “a rear wall” to make the use of the term in claim 3 consistent with the specification. Figure 5 is amended to identify side walls 114 and 116 as described in the specification. The specification expressly describes that the surfaces of the stanchions are attached one to another as follows (see Page 11, lines 27-31):

A top stanchion surface 124 is integrally attached to the front surface 112, the side walls 114, 116 and the upper rear wall 120. Similarly, a bottom stanchion surface 126 is integrally attached to the front surface 112, the side walls 114, 116 and the lower rear wall 122.

Applicants respectfully submit that the description of the specification is consistent with and supports claim 3.

Second, the Office Action asserts that the meaning of the phrase, “integrally attached” in the specification is unclear and that if parts are attached, they must be separable. It is well settled

that applicants may be their own lexicographers. Unless the terms are used contrary to accepted meaning in the art, applicants may use terms that they choose. The ordinary meaning of the term, “attach” is “join” or “fasten” or “connect.” See The New Oxford Dictionary of English 107 (1998) and Random House Webster’s Unabridged Dictionary 133 (2d ed. 2001). No dictionary meaning indicates that the attached parts must be separable. Nevertheless, the Office Action asserts, without support, that the accepted meaning in the art is that attached parts must be separable.

The dictionary meaning of the term, “integral” is “formed as a unit with another part.” See Merriam-Webster’s Collegiate Dictionary 650 (11th ed. 2003). The Federal Circuit has interpreted the term, “integral” to “cover more than a unitary construction.”¹ As interpreted by the Board of Patent Appeals and Interferences, the term, “integral” is “a relatively broad term inclusive of means for maintaining parts in a fixed relationship as a single unit.”² Also, it can be interpreted broadly to “encompass multi-piece structures.”³ It is sufficiently broad to “embrace constructions united by such means as fastening and welding.”⁴

Based on the above, Applicants submit that the phrase, “integrally attached” as used in this application would have been readily understood by one of ordinary skill in the art and so the rejection is improper.

Third, the Office Action asserts that the inner wall 116 and the outer wall 118 are not identified in Figures 5-11, and that if the front wall 112 has been attached to the integral walls,

¹ In re Morris, 127 F.3d 1048, 1055-56, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997).

² In re Morris, 127 F.3d at 1053, 44 USPQ2d at 1027.

³ In re Morris, 127 F.3d at 1055, 44 USPQ2d at 1029.

⁴ See, Advanced Cardiovascular Systems, Inc. v. Scimed Life Systems, Inc., 887 F.2d 1070, 1072, 12 USPQ2d

the attachment means is not described and it is not shown as a separate part. Applicants submit that the Office Action mislabels the “side wall 116” as the “inner wall 116,” “opening 118” as the “outer wall 118,” and the “front surface 112” as the “front wall 112.” Figures 5-11 have been amended to identify side wall 116. Figures 5-7 originally have identified the opening 118. Figure 9 has been amended to identify the opening 118.

Applicants submit that the accepted meaning of the phrase, “integrally attached” as discussed above does not require that either attachment means be shown or the front surface 112 be shown as a separate part from side walls. The front surface 112 is integrally attached to side walls 114 and 116, the top and the bottom surfaces 124, 126, and rear walls 120, 122, and forms a stanchion with them. Applicants submit that such use of the phrase, “integrally attached” is well understood in the art.

Fourth, the Office Action asserts that the top stanchion surface 124 and the bottom stanchion surface 126 appear to be an upper and a lower edge of a side wall, respectively, in Figure 5. Applicants respectfully submit that the top stanchion surface 124 and the bottom stanchion surface 126 are not the edges of the side wall. Page 12, the last paragraph of the specification expressly describes that surfaces 124, 126 of the stanchion are not the edges of the stanchion as follows:

“In particular, the trapezoid has a top edge 132 ... a base 134 ... a front edge 136 ... a rear edge 138 As shown in FIGS. 5-7, the front surface 112 and the front edge 136 are angled relative to the top stanchion surface 124 by an obtuse angle θ Furthermore, the edges of the rear walls 120, 122 and the cover 130 and the rear edge 138 are approximately perpendicular to the top and bottom stanchion surfaces 124, 126.”

1539, 1541 (Fed. Cir. 1989) (citing In re Hotte, 475 F.2d 644, 647, 177 USPQ 326, 329 (CCPA 1973)).

In addition, Applicants have amended Figure 5 to identify the edges 132, 134, 136 and 138 and distinguish them from surfaces. Applicants have amended Figures 5, 10 and 11 to identify the top and the bottom stanchion surfaces 124, 126. Applicants submit that top stanchion surface 124 and the bottom stanchion surface 126 indicate rectangular shaped areas, formed at the top and the bottom of the stanchion, respectively. The specification on page 11-12 describes the top and bottom stanchion surfaces as follows:

The top stanchion surface 124 is approximately rectangular in shape having a length of approximately 4.25 inches and a width of approximately 1.125 inches. The bottom stanchion surface 126 is parallel to the top stanchion surface 124 and is rectangular in shape having a length of approximately 6.1 inches and a width of approximately 1.125 inches. The bottom stanchion surface has a threaded opening to receive a threaded bolt of an adjustable floor support 128 where rotation of the threaded bolt results in raising or lowering the floor stanchion relative to the floor 102.

The specification on page 26 describes the top stanchion surface that “[t]he spacer 284 has a pair of holes that are aligned with corresponding threaded holes formed in the top section surface 124.” Applicants submit that the top stanchion surface 124 and the bottom stanchion surface 126 are not edges but surfaces that have a threaded opening or threaded holes.

Based on the foregoing, Applicants respectfully submit that the Office Action fails to provide a reasonable basis to rebut the presumption of the adequacy of the written description. Claims 3-7 are adequately described in the specification such that the ordinary skilled in the art can recognize that Applicants had possession of the claimed invention at the time of filing. Thus, Applicants request the Examiner to withdraw the pending rejections.

2. 35 U.S.C. § 112, second paragraph.

Claim 10 is objected to under 35 U.S.C. § 112, second paragraph as being indefinite.

The Office Action appears to assert that the subject matter of claim 10 is not described in the specification. The Office Action specifically asks “[w]here is it disclosed that less than the m number of hooks are inserted into a similar n number of holes?” The Office Action then asserts that claim 10 is indefinite, not because claim 10 fails to particularly point out and distinctly claim the subject matter, but rather because the specification does not disclose the subject matter of claim 10. Applicants offer that this reasoning is not a proper basis for rejection under 35 U.S.C. § 112, second paragraph, since the statute only regards the adequacy of the claims.

Applicants further submit that the subject matter of claim 10 is adequately described in the specification. The specification on page 17 describes an embodiment of the claimed feature of claim 10 as follows:

“As shown in FIGS. 1 and 26, the curved brackets 174, 176 ... have $m=6$ number of hooks 178 that are inserted into a plurality of vertical slots 180 that are formed in the front surface 112 Note that the number n of slots is preferably 12. If the number of slots 180 is greater than the number of hooks, then the hooks 178 can be positioned at more than one position (number of positions = $n-m+1$). Accordingly, the worksurface member 104 is adjustable in height relative to the floor 102 by adjusting the location of where the brackets 174 and 176 are attached.”

The phrase “[i]f the number of slots 180 is greater than the number of hooks” clearly implies that the inventors contemplated the number of slots being equal to the number of hooks since that would prevent multiple positions. In order to emphasize this, the paragraph has been amended to explicitly state that the number of slots can be equal to the number of hooks.

Based on the above, Applicants submit that the objection is improper and should be withdrawn.

C. 35 U.S.C. § 103

Claims 1-21 were rejected under 35 U.S.C. § 103 as being obvious in view of Mollenkopf (U.S. Patent No. 5,901,513) and further in view of Canfield et al. (U.S. Patent No. 5,544,593) and Behrendt (U.S. Patent No. 5,754,995) and the ordinary skill in the art. Applicants respectfully traverse the rejections and request the Examiner to withdraw the pending rejections in light of the following remarks.

1. Claims 1-16

The Office Action asserts that it would have been obvious to have modified Mollenkopf with stanchions having a trapezoidal shape in view of Behrendt, and with brackets having a J-shape for supporting wires, and with slots in the stanchion and hooks in the bracket to adjustably support the worksurface in view of Canfield et. al. Applicants have canceled claims 1, 15, so their rejection has been rendered moot. Regarding claims 2-16, claim 14 has been amended to be an independent claim, and claims 2-3, 8, 12-13 have been amended to depend on claim 14.

Independent claim 14 recites a modular desk having a worksurface member, a first floor stanchion and a second floor stanchion, and a J-shaped bracket. The J-shaped bracket is attached to the first and second floor stanchion. The first floor stanchion has a trapezoidal shape. On the other hand, neither Mollenkopf nor Canfield teaches or suggests the J-shaped bracket and the first and the second floor stanchions defined in claim 14.

Mollenkopf discloses a modular work station that has superstructure uprights 12, panel 14 and a work top 20. Canfield discloses a desk top system that has uprights 11, panel 18, desk tops 20, cantilevered desk top supports 16 and foot pedestal supports 14. The Office Action

concedes that Mollenkopf does not teach or suggest the J-shaped bracket. The Office Action asserts, however, that Canfield discloses a trough/bracket that is more or less J-shape and attached to the uprights and a panel by brackets 155.

Applicants submit that there is no motivation to modify Mollenkopf with the trough/bracket disclosed in Canfield. While Mollenkopf cites in column 2, lines 45-56 the patent number of Canfield, it does not refer to the trough or bracket disclosed in Canfield. Rather, it is referring to cantilever foot pedestal support member 16 and uprights formed in two interlocking sections and is silent as to using the recited J-shaped bracket. Other than Applicants' disclosure, no suggestion or motivation exists in either Mollenkopf or Canfield to modify Mollenkopf with the trough/bracket of Canfield.

Applicants respectfully submit that even if Mollenkopf may be modified with the trough of Canfield, Canfield does not teach the limitation of a "J-shaped bracket." The trough 86 and a bracket 155 disclosed in Canfield are not attached to the uprights 11A (i.e., stanchions) but to a panel 18. See column 8, line 57- column 9, line 11 and Figures 22-24. Furthermore, neither the trough 86 nor the bracket 155 has the claimed J-shape shown by Figures 23-24 of Canfield. Thus, combining Mollenkopf with Canfield does not teach or suggest the J-shaped bracket attached to the stanchions because neither Mollenkopf nor Canfield discloses such a bracket.

The Office Action concedes that neither Mollenkopf nor Canfield discloses trapezoidal stanchions. The Office Action asserts, however, that trapezoidal shape of the stanchions is a matter of design choice and that it is well known to use the trapezoidal shape for the stanchion in view of Behrendt. Applicants submit that there is no motivation for a person having ordinary

skill in the art to modify the uprights disclosed in either Mollenkopf or Canfield to have a trapezoidal shape in view of Behrendt. Mollenkopf and Canfield do not teach that the shape of the uprights can be changed to the trapezoidal shape as a matter of design. Rather, Mollenkopf and Canfield implicitly teach away from such modification. Because uprights in both Mollenkopf and Canfield are hollow, it would be more difficult and costly to fabricate the uprights as a trapezoidal shape. Members adjacent to the uprights, such as cantilever foot pedestal support members and support cantilever desk support member, would also need changes in the shapes and designs, to be connected with the uprights modified with the trapezoidal shape. There is no suggestion, other than Applicants' description of the invention, to modify uprights disclosed in Mollenkopf and Canfield to have the trapezoidal shape.

Even if the uprights are modified to have the trapezoidal shape in view of Behrendt, neither Mollenkopf nor Canfield discloses the modular desk defined in claim 14, which recites a J-shape bracket attached to the first and the second stanchions having the trapezoidal shape. Thus, the rejection of claim 14 and its dependent claims is improper and should be withdrawn.

2. Claims 17-21

Claims 17-21 are patentable under 35 U.S.C. § 103(a) because the prior art does not teach or suggest "a J-shaped bracket attached to said first floor stanchion and said second floor stanchion; and a second bracket attached to said first floor stanchion and said second floor stanchion."

Independent claim 17 recites a modular desk having a worksurface, a first and a second floor stanchions, a J-shaped bracket and a second bracket. The J-shaped bracket and the second

bracket are attached to the first and the second floor stanchion. The Office Action concedes that Mollenkopf does not disclose the J-shaped bracket. The Office Action asserts that Canfield discloses a trough/bracket that is more or less J-shaped attached to the uprights and the panel by bracket 155. The Office Action does not assert, however, that Canfield discloses the second bracket defined in claim 17 and that if so, whether bracket 155 is the second bracket. Applicants respectfully submit that the Office Action does not provide a prima facie case of obviousness by failing to prove that the combination of the cited references teach all limitations of claim 17.

Nevertheless, Applicants offer that Canfield does not disclose the J-shaped bracket that is attached to the first and the second floor stanchion. As mentioned previously in Section C.1, Canfield discloses the trough 86 that is attached to the panel 18 by the bracket 155. See Figures 23 and 24; column 8, lines 63-65. Neither the trough nor the bracket 155 has a J-shape. There is no motivation to modify Mollenkopf with the trough of Canfield, other than Applicants' disclosure. Even if Mollenkopf is combined with Canfield, the combination does not teach or suggest all limitations of claim 17, because Mollenkopf fails to teach or suggest any bracket. In addition, there is no motivation to modify such combination to have the trapezoidal shape uprights in view of Behrendt. Even if modification occurs, there is no teaching or suggestion of the modular desk defined in claim 17, because Behrendt does not teach or suggest any bracket used for the desk system. Thus, the rejection of claim 17 and its dependent claims 18-21 is improper and should be withdrawn.

D. New Claims 102 - 114

New claim 102 depends directly on claim 10 and so is patentable for at least the same reasons given above in Section C.1. Claims 103-105 depend directly or indirectly on claim 14 and so are patentable for at least the same reasons given above in Section C.1. The claims are patentable for additional reasons that they each cite that the J-shape bracket includes a horizontal surface and two vertical surfaces attached thereto and that entirely extend upward. None of the cited references, either alone or in combination, discloses such a structure for a J-shaped bracket. Thus, claims 103-105 are patentable and should be allowed.

Claims 106-114 depend directly or indirectly on claim 17, and so are patentable for at least the same reasons given above in Section C.2. The claims are patentable for additional reasons that they cite that the J-shaped bracket or the second bracket includes a horizontal surface and two vertical surfaces attached thereto and that entirely extend upward. None of the cited references, either alone or in combination, discloses or suggests such structure. Thus, claims 104-114 are patentable and should be allowed.

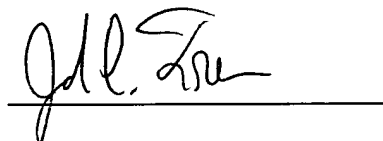
Please note that new claims 104-114 are being presented to provide additional coverage for a modular desk system and so are not being presented for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002).

CONCLUSION

In view of the arguments above, Applicants respectfully submit that all of the pending

claims 2-14, 16-21 and 102-114 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John C. Freeman", is written over a horizontal line.

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Dated: November 6, 2003

APPENDIX



Annotated Marked-up Drawings

FIG. 5

FIG. 6

FIG. 7

FIG. 8

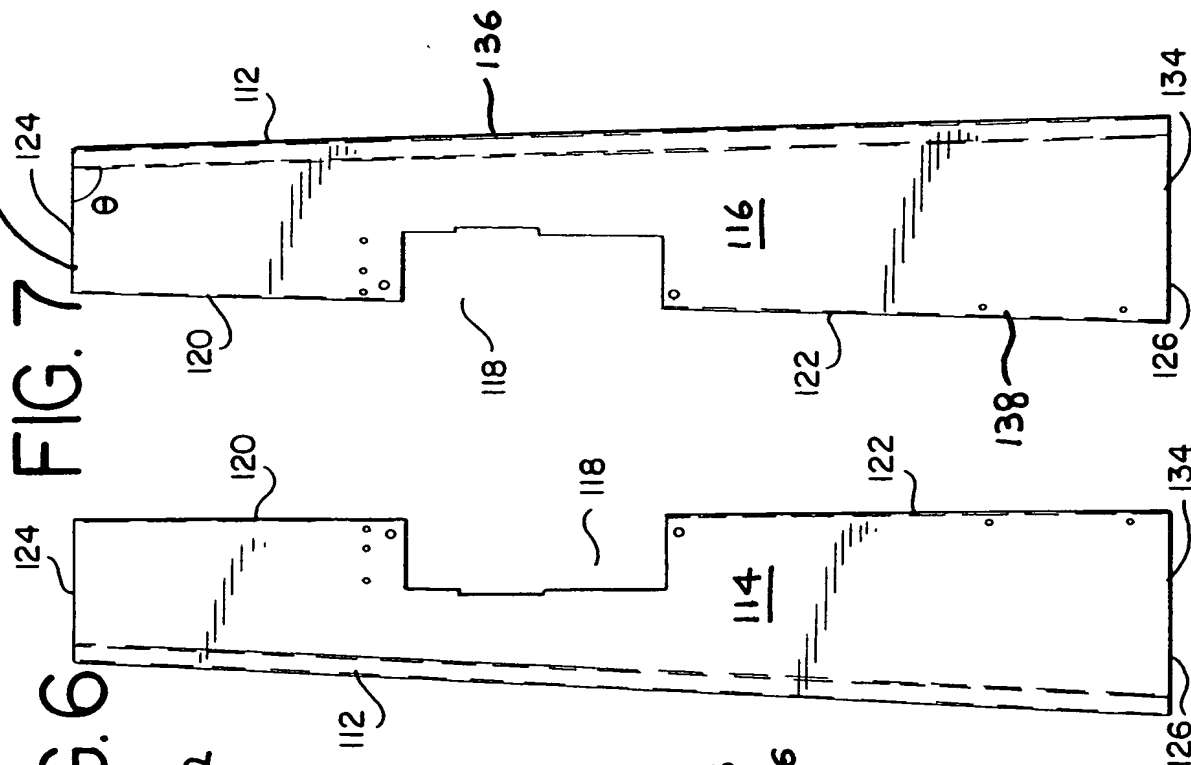
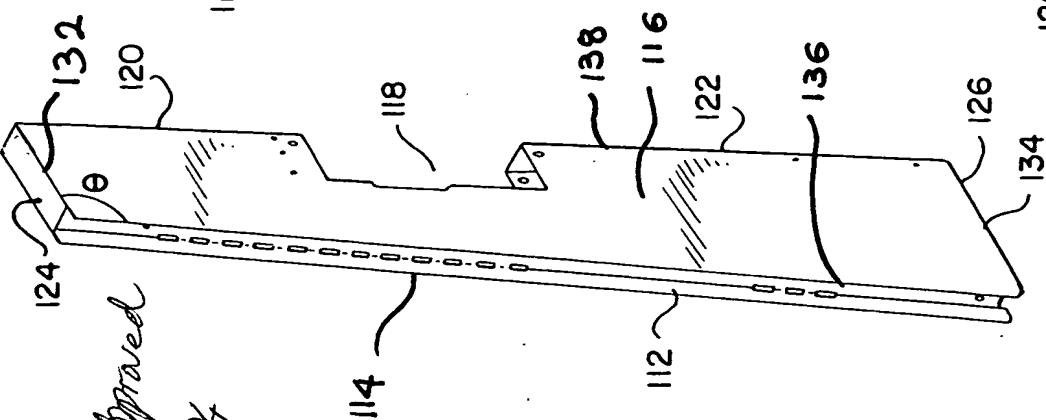


FIG. 9

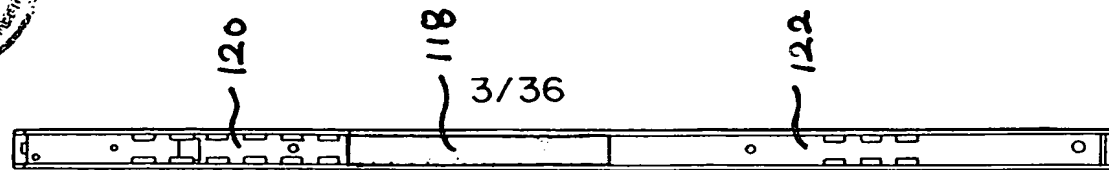


FIG. 10

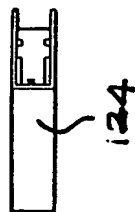
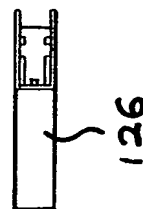


FIG. 11





Annotated Marked-up Drawings

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FIG. 80B

FIG. 80A

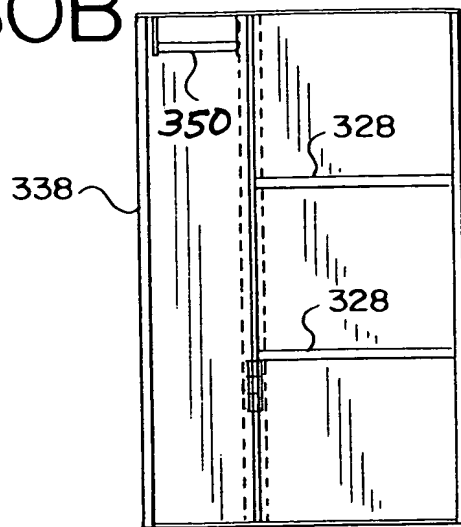
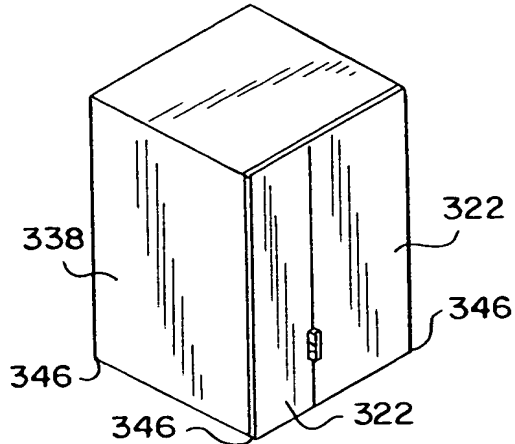


FIG. 81A

FIG. 81B

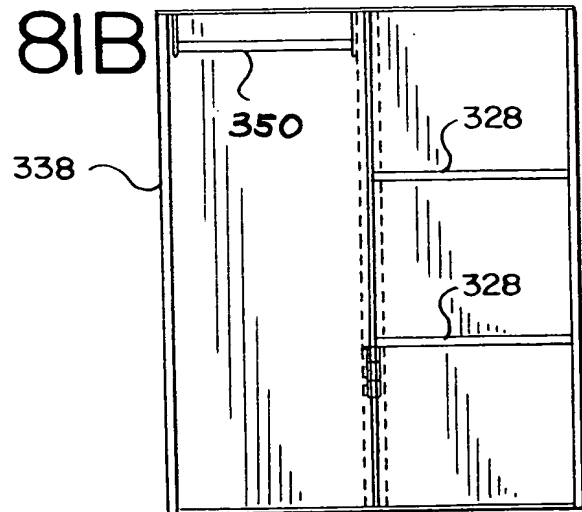
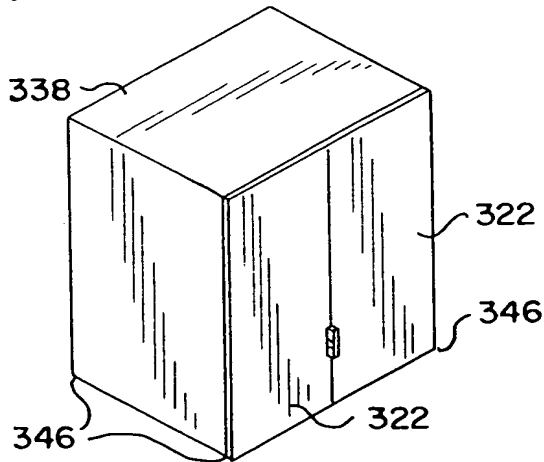


FIG. 82A

FIG. 82B

